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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1974

No.

DR. JERRY BLUMBERG,

PETITIONER,

VS.

BAUSCH & LOMB OPTICAL COMPANY,

RESPONDENT,

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

To the Supreme Court of the United States of America:

Petitioner respectfully prays that a writ of certiorari issue to review the opinion of the United States Court of Appeals For The Sixth Circuit rendered in these proceedings on July 2, 1974.

OPINION BELOW

The opinion of the United States Court of Appeals for the Sixth Circuit, appears at Appendix A infra, page 1 The opinion of the U.S. District Court for the Eastern District of Michigan, unreported, appears at Appendix B

JURISDICTION

The Judgment of the Court of Appeals was entered on July 2, 1974, see Appendix A page one infra. This Petition for Certiorari was filed less than 90 days from the date aforesaid, (extension of time for filing granted to and including November 29, 1974).

The Jurisdiction of the Court is involved under 28 U.S.C. par. 1257 (3).

THE QUESTIONS PRESENTED

I. SHOULD THE UNITED STATES SUPREME COURT GRANT CERTIORARI IN THE INSTANT CASE TO RESOLVE THE QUESTION, ON WHICH THERE IS A CONFLICT IN THE COURTS OF APPEALS, AS TO WHAT EXTENT STATE LAWS WHICH PROTECT STATE TRADE-MARKS, SERVICE MARKS, AND WHICH RESTRICT UNFAIR COMPETITION AND UNFAIR TRADE PRACTICES ARE PRE-EMPTED BY FEDERAL PATENT LAWS?

II. DID YOUR PETITIONER, A LICENSED OPTOMETRIST, BY PERSONALLY WEARING AND DISPLAYING TO THE PUBLIC AND TO HIS PATIENTS IN HIS OFFICE, A UNIQUE AND DISTINCTIVELY OUTLINED SPECTACLE FRAME IN CONNECTION WITH HIS PROFESSIONAL DRESS AND UNIFORM FOR A PERIOD OF OVER 20 YEARS PRIOR TO THE FILING OF THIS ACTION, WHICH FRAME HAD NEVER BEEN WORN BY ANYONE ELSE IN THE U.S.A. PRIOR TO PETITIONER'S USE THEREOF AS A MARK, AQUIRE A PROPRIETARY INTEREST AND PROPERTY RIGHT IN SUCH DRESS AS TO INVOKE PROTECTION THEREOF BY STATE LAW?

FEDERAL LAW INVOLVED

Title 28, § 2201:

" In case of actual controversy within its jurisdiction, except with respect to Federal taxes, any court of the United States, upon filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such."

Title 28, § 1338:

"a. The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

b. The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trade-mark laws."

Federal Rules of Civil Procedure for the District Courts, Rule 15:

a. Amendments. "....Otherwise a party may amend his pleadings only by

leave of court or by written consent of the adverse party; and leave shall be freely given when justice so requires....."

STATE LAW INVOLVED

Trademarks and Service Marks (Michigan)

Act 242, 1969, p 468; eff January 1, 1970.

AN ACT to provide for the registration of trademarks and service marks; to prescribe the powers and duties of the Secretary of state; to prescribe remedies; and to repeal certain acts and parts of acts.

The people of the State of Michigan enact:

"a. "Trademark" means any word, name, symbol or device, or any combination thereof, other than a trade name in its entirety, adopted and used by a person to identify goods made or sold by him and to distinquish them from similar goods made or sold by others."....."e. "Service mark" means any word, name, symbol or device, or any combination thereof, other than a trade name in its entirety, adopted and used by a person in the sale or advertising of services to identify his services and distinquish them from the similar services of others."

"f. "Mark" includes any trademark or service mark."

"g. "Trade name" means a word or group of words used by any person to identify a sole proprietorship, firm, partnership, corporation, association, union or

other organization.

"h. A mark is "used" in this state on goods when it is placed in any manner on the goods or their containers or on the tags or labels affixed thereto and such goods are sold or otherwise distributed in the state, and on services when it is used or displayed in this state in the sale or advertising of services and the services are rendered in this state."....
Michigan Statutes Annotated §18.638(23) Sec. 3; Michigan Compiled Laws, 1948, §429.33.

Section 14. Nothing contained in this act shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.
M.S.A. §18.638(34); CL"48, §429.44.

STATEMENT OF THE CASE

Plaintiff, an optometrist, brought his action for declaratory judgment, injunctive relief, and damages for wrongful use of a patent issued to respondent and for unfair competition by respondent in its copying and using in advertising literature, features of a spectacle frame in which petitioner claims he has obtained a service-mark or trade-mark distinquishing his business or occupation from other opometrists in his area.

This case was filed by petitioner June 18, 1973, and service made upon respondent included with plaintiff's complaint photographs of the plaintiff wearing the unique eyeglass frame, and photographs of the unique frame itself.

Additional photographs included in said complaint disclosed a strikingly similar frame which was patented by respondent approximately 6 years after petitioner's public use thereof as a mark or symbol of his business, and photgraphs of advertising literature disseminated by respondent to optometrists in petitioner's immediate area to sell its spectacle frames.

The complaint comprised two counts, one for wrongful use of an allegedly invalid patent, and one for unfair competition alleging that respondent copied well-known features of petitioner's spectacle frame which petitioner wore in his business establishment as a service mark or symbol of his profession.

The acts precipitating this action began in the year of 1949, when petitioner, while in Paris, France, observed a particular design for an eye glass frame wherein the upper part thereof is slitted and bent rearwardly to form unique " eye-catching" wing-tips which frame petitioner wore personally for improving his professional prestige and for the purpose of advertising and presenting to the public his services as an optometrist.

Petitioner wore his frame in and about his office as a distinctive dress to create a unique appearance associated with his profession as an optometrist for a period of approximately five years prior to the issuance to respondent of a design patent no. 175,050 on a strikingly similar spectacle front. In comparing said patent design to petitioner's frame it is obvious that respondent's frame embodies essentially the same unique "wing-tip" construction as petitioner's frame.

Respondent distributed other liter-

ature showing similar eye-glass frames utilizing petitioner's service mark which apparently were not covered by such [illegible], as evidenced by the photographs referred to supra.

Respondent sent or transported into the state of Michigan such pictoral literature displaying its frames which were like petitioner's on cards showing models wearing such frames.

Respondent's literature was distributed to offices of other optomitrists and opticians in the State of Michigan at the instance of responent, which cards used petitioner's unique effect when worn.

Once respondent or its agents, employees, or representatives displayed petitioner's frame or similar frame being worn by others on cards sent to the offices of optometrists competing with petitioner, the uniqness and striking effect of petitioner's symbol or dress was diluted causing great damage to petitioner's professional standing and causing him loss of income from his professional services.

Continual demand was made upon respondent by petitioner to cease and desist from using and displaying such frame of respondent's on display cards and similar literature which advertised its products, letters were written by petitioner to respondent in 1960 telling æspondent that the frame they were using was petitioner's trademark, and that respondent was infringing th ereon, or words to that effect, but respondent refused to comply with petitioner's demands to petitioner's detriment.

Respondent brought on a motion to dismiss in the district court which was duly answered by petitioner. A hearing was had on such motion, without introduction of evidence or taking of testimony, on the part of plaintiff, and the district court granted such motion with predjudice.

An appeal from such order of dismissal was timely made by petitioner to the United States Court of Appeals for the Sixth Circuit.

The Decision of said United States Court of Appeals affirmed the judgment of the District Court in a short opinion without, in effect giving extended treatment to defendant's argument that respondent had an invalid patent and that respondent had unfairly competed with petitioner by disseminating advertising literature using petitioner's service mark or symbol of his business.

The United States Court of Appeals dismissed the petitioner's appeal of the District Courts decision on the grounds that it found no error in the District Courts finding of facts and conclusions of law. Thus, in effect, the petitioner is denied his right to a plenary hearing on the material issues, supra, with the right to cross-examine the respondent's witnesses and present additional evidence.

The petitioner is deprived of his property right in his service or trademark without any legal process or compensation by the action of the court of appeals in affirming the order of dismissal of the District Court and your petitioner is without remedy except by petition for a writ of certiorari from that decision of the Court of Appeals for the Sixth Circuit.

REASONS FOR GRANTING THE WRIT

1. There is a conflict in the courts of appeals as to the extent state laws which protect state granted trademarks, service marks, and which restrict unfair competition and unfair trade practices are pre-empted by federal patent laws in view of the Sears and Compco cases.

The extent of the conflict and confusion present in the state courts, federal courts and among legal scholars is evident from a perusal of the work on the subject by Paul Goldstein, Copyright, Patent, Trademark and Related Doctrines, published by Callaghan and Company, 1973, in which he quotes from Goldstein, The Competitive Mandate; From Sears to Lear, 59 Calif L Rev 873-880; 895-896; 898-899; 903-904; (1971) as follows:

Page 2-3:

"The Supreme Court has in recent years renewed its attention to the economy's governing competitive principles. The Court's approach to these principles has been most explict, and most problematic, in a series of cases involving administration of the monopolies effected by the state law of trade secrets, common law copyright, unfair competition and contract."....

page 3:

" Probably because the Court's answers lack the closely reasoned premises necessary for consistent and principled decision, they have been largely misapplied,

circumscribed or ignored by state and lower federal courts and have stirred no little confusion among scholars. The absence from the decisions of neutral and broadly applicable principles is specifically attributable to the Court's failure to grasp or, at least, explicate fully two important contextual implications. First, these decisions are rooted in the nation's historic commitment to a competitive economy and in the modern premise that competition can be maintained only through government interference in enterprise conduct. One relevant and particularly traditional method of interference has been the government's provision for artificial incentive through the grant of legal monopolies--patent, copyright, trademark, trade secrets, common-law copyright and unfair competition. Second, the Court failed to discern the similarity between these cases and contemporary decisions in which, for example, state laws and practices governing criminal procedure or regulating individual speech have been tested to determine their consonance with federal constitutional standards."....

On page 145 of said work (Copyright, Patent, Trademark and related Doctrines), Golstein quotes from Derenberg, Product Simulation: A Right or Wrong, 64 Colum L Rev 1192-93 (1964) , at the bottom of said page as follows:

"Although the obscurity of the Sears and Compco opinions has provided good sport

for academics, it has proved troubling to state and lower federal courts; there has been a discernible trend to distinquish, dismiss, or simply ignore the two decisions. The inconsistency they have stirred in one jurisdiction is indicated by a comparison of Riback Enterprises, Inc. v. Denham, 452 F2nd 845, 172 USPQ 33 (2nd Cir 1971), with Flexitized, Inc. v. National Flexitized Corp. 335 F2nd 774, 142 USPQ 334(2nd Cir). cert den 380 US 913 (1964)."....

Again on page 146, par. 3, middle of par:

....."The relationship between secondary meaning and functionality has remained unclear, complicating already difficult problems of burden of proof. The theory of aesthetic functionality, though ignored by some courts, has been applied by others to overalls, toggle clamps, and can openers, but not to unusual china ash trays. Judge Learned Hand's often cited dictum that functionality is relevant only to the scope of relief has been disregarded by many courts which consider functionality crucial in determining intent. The courts have split several ways on whether imitation of functional features may be enjoined. Absent deceptive practices, imitation is generally permitted, particularly if the copyist adopts distinctive packaging; Judge Hand, however, reserved the right to enjoin imitation of trivial features. The Sixth Circuit, which broadly priveleges imitation of nonfunctional features, and the Seventh, which apparently prohibits imitation of functional features even when no likelihood of confusion as to source exists, have taken opposite and extreme positions."....

In the recent case of Kewanee Oil Co.

v. Bicron Corpation et al, this Court granted certiorari to resolve a question on which there was a conflict in Courts of Appeals as to whether state trade secret protection is pre-empted by operation of the federal patent law.

Petitioner suggests that the instant case is a vehicle to resolve the question as to confict in the Courts of Appeals whether state trademark and unfair practices and unfair competition protection is pre-empted by federal patent law.

Petitioner suggests that the law respecting trademarks, copyrights, and unfair competition is in the same state at the present time that the law of trade secrets was before this Court's decision in the Kewanee case, and there is a desperate need for this court to clear the muddy waters of confusion with respect to interaction of the patent laws with trademark, copyright, and unfair competition law.

It is your petitioner's considered opinion that the Kewannee case preserved the right to trade secret protection by the states, and that the same logic that prompted the Kewannee decision is applicable to the case at bar.

This Court in said Kewannee:

"In the 1972 Term, in Goldstein v. California, 412 US 546, 37 L Ed 2nd 163, 93 S Ct. 2303 (1973), we held that cl 8 grant of power to Congress was not exclusive and that, at least in the case of

writings, the States were not forbidden from encouraging and protecting the efforts of those within their borders by appropriate legislation."....

Again this Court said in such decision,:

"The patent law does not explicitly endorse or forbid the operation of trade secret law."

May your petitioner be so bold as to infer from these words that the patent law does not explicitly endorse or forbid the operation of trademark, service mark, copyright, or unfair competition passed by the States in protection of such rights?

This Court went further in said Kewannee stating:

[15] The maintenance of standards of commercial ethics and the encouragement of invention are the broadly stated policies behind trade secret law. "The necessity of good faith and honest, fair dealing, is the very life and spirit of the commercial world.", (quoting cases),

"the court emphasized that even though a discovery may not be patentable, that does not

"" destroy the value of the discovery to one who makes it, or advantage the competitor who by unfair means, or as the beneficiary of a broken faith, obtains the desired knowledge without himself paying the price in labor, money, or machines expended by the discoverer.""

May your petitioner suggest that the reasoning of this Court supra applies equally to the facts of the case at bar? Petitioner made no claim to having a right to a patent, in fact he clearly states in his statement of the case that he discovered the unique frame that he used as a service mark in Paris, France. Under patent laws he could not patent same, and respondent could not have acquired a design patent thereon if such knowledge had been available to the Patent Office. However, petitioner used said unique frame as a symbol of his business and profession by wearing same continuously for approximately 20 years in his office, would not this use entitle petitioner to protection as set forth in Michigan State Law of long standing which provides for the aquisition of service and trademarks by registration and at common law?; and for protection under the case law of the State of Michigan which provides as follows:

> "unfair competition consists in the simulation by a person of the name, symbols or devices employed by a business competitor for the purpose of deceiving the public, or the substitution of the goods or wares of one person for those of another, thus falsely inducing the buying of his goods and by such methods obtaining for himself profits belonging to a business rival."
> Clipper Belt Lacer Co. v. Detroit belt Lacer Co., 223 Mich. 399. (194 NW 125); Schwannecke v. Genesee Coal and Ice Co. 262 Mich. 624,247 NW 125, Bell v. Service Coal Co., (273 NW 435); 280 Mich. 172; Moon Brothers v.

Moon, 300 Mich. 150, (1 NW 2nd 488, 1942); Belvidere Land Company v. Owen Park Plaza, Inc. 362 Mich. 107, 106 NW 380 (1960).

As far as petitioner can ascertain, there are no pertinent decisions regarding this issue after the Sears and Compco cases in Michigan.

II. Petitioner, a licensed optometrist, by personally wearing and displaying to the public and his patients in his office a unique and distinctively outlined spectacle frame in connection with his professional dress or uniform for a period of over 20 years prior to the filing of this action, which frame had never been worn by anyone else in the U.S.A. prior to petitioner's use thereof, acquired a proprietary interest and property right in such dress as to invoke protection therefore by State Law.

In view of the Michigan definition of the law of unfair competition, supra, it would appear that petitioner is entitled to protection for his use of the special spectacle frame against all others in the field., except for the holding of the District Court and the Court of Appeals which did not follow Michigan law and which dismissed petitioner's case based on its finding that petitioner was "attempting to obtain a trademark in an article"

Petitioner contends that the facts as outlined herein do not show that he was attempting to get a trademark in an article; he was obtaining a trademark or symbolic use of the unique eye-glass frame by wearing same as an optometrist as an eye-catching item of dress to draw attention to his services as an optometrist.

This Court also ruled in the Kewannee case that:

> "Even as the extension of trade secret protection to patentable subject matter that the owner knows will not meet the standards of patentability will not conflict with the patent policy of disclosure, it will have a decidedly beneficial effect on society. Trade secret law will encourage invention in areas where patent law does not reach, and will prompt the independent innovator to proceed with discovery and exploitation of his invention. Competition is fostered and the public is not deprived of the use of valuable, if not quite patentable, invention."

Petitioner submits that protection of trademarks, copyrights, and protection from unfair competition will also have a beneficial effect on society, by fostering fair play in business relationships, and rendering stability to the flow of commerce.

Petitioner submits that under the facts of this case, his symbol or trademark is worthy of protection under state law, taken in view of this Court's holdings in said Kewannee precedent.

Other cases in which possible conflicts or conflicts of law appear and which support petitioner's position are as follows:

> "Motion for summary Judgment cannot be granted unless it is clear that there is no genuine issue of material fact and all inferences must be drawn from the evidence in favor of the party against whom the motion is made."

Sinock v. Roman, (DC-Del), 232 F Supp 844.

Also:

"Summary judgment under this rule is very limited and is not a facility intended to be employed as a calender-cleaning device at the expense of the possibility of not doing full and ccmplete justice to any litigant by trial of a case involving a complicated question.
In Re Smith v Enochs, (DC-Miss), 233 F Supp 925.

Further, with respect to the interaction of patent, trademark, copyright and unfair competition laws:

That a device can be both trademarked, or patented if meeting the requirements of patentability, is clear: (prior to Sears and Compco)

It was held:

"Fact the design patent has been obtained on the shape of a bottle does not render it impossible to register the bottle as a trademark. Patent rights are separate and distinct from those appertaining to trademarks." In re Mogen David Wine Corp., 51 CCPA 1260, 328 F 2nd 925, 140 USPQ 575, rev'g 134 USPQ 576.

The above decision would appear to be in direct conflict with the Sixth's Circuit's holding in the instant case.

Further, in reverse order, it has been held that although respondent had a design patent, this would not authorize respondent to use same as a trademark,

It was held:

> "Design Patent could not have been made to operate as a trademark." Goodyear Tire & Rubber Co. v. Robertson. (DC), 18 F 2nd 639. Aff'd 25 F2nd 833.

In Coca-Cola Co. v. The Koke Co. of America, 254 US 143 (1920) the Court ruled that, although plaintiff's product contained only trace amounts of coca leaf and cola nut derivative, "we are dealing here with a popular drink not with a medicine... Coca-Cola probably means to most persons the plaintiff's familiar product to be had everywhere rather than a compound of particular substances."

Petitioner submits that the name "Coca-Cola"is not patentable.

CONCLUSION

For these reasons, a writ of certiorari should issue to review the opinion and judgment of the Court of Appeals for the Sixth Circuit.

Respectfully submitted,

Gerald R. Hershberger, J.D.
285 E. Long Lake Rd.
Troy, Michigan

Attorney of Record

for Petitioner

November 23, 1974

APPENDIX A

No. 73-2237

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

Dr. Jerry Blumberg,

Appellant,

v. ORDER

Bausch and Lomb Optical Company,

Appellee.

Before: CELEBREZZE and LIVELY, Circuit Judges, and WEINMAN, * District Judge.

This is an appeal from a judgment dismissing Appellant's action for failure to state a claim upon which relief can be granted. Appellant sought a declaratory judgment that a patent granted to Appellee in 1955 on a type of eye glass frame was invalid and that Appellee copied Appellant's design and improperly used the design in its advertising literature. It is contended by Appellant that he had a trademark in the frame design and that the use of it by Appellee unfairly competed with Appellant.

Upon consideration of the briefs, the record and oral arguments, and finding no error in the District Court's finding of facts and conclusions of law it is ORDERED that the judgment of the District Court be and is hereby affirmed.

ENTERED BY ORDER OF THE
COURT
John P. Hehman
Clerk

*Carl A. Weinman, Senior District Judge, United States District Court for the Southern District of Ohio, sitting by designation.

APPENDIX B

UNITED STATES DISTRICT COURT
FOR THE
EASTERN DISTRICT OF MICHIGAN

Dr. JERRY BLUMBERG, O.D.

Plainitff

vs.

BAUSCH AND LOMB OPTICAL COMPANY,

Defendant.

Civil Action No. 40293

ORDER GRANTING DEFENDANT'S
MOTION TO DISMISS

On the 24th day of September, 1973 came on to be heard before the Court, the Honorable Cornelia G. Kennedy, District Judge presiding, defendant's motion to dismiss the plaintiff's complaint, with prejudice, and with costs being assessed against plaintiff, and after due consideration thereof,

IT IS HEREBY ORDERED, AND ADJUDGED AND DECREED that the said motion shall be and is hereby granted.

Dated this 27 day of September, 1973.

Cornelia G. Kennedy
United States District
Judge